



are no restrictions on the individual amounts of surfactants." Page 2, lines 20-21.

However, the Office has misapplied the law of anticipation and inherency in making this rejection.

In order to be anticipated "[t]he identical invention must be shown in as complete detail as in the... claim." M.P.E.P. § 2131 (*quoting Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed.Cir. 1989)). Since the Office has already acknowledged that Morlino does not disclose in any detail the claimed ratio, there can be no anticipation. However, for the sake of completeness, Applicants will address and refute the arguments apparently implicit in the Office's rejection.

First, the Office's statement that "Morlino's claims encompass the recited ratio of the instant invention" (Office Action, page 3, lines 1-2) suggests that the Office is viewing the relationship between Morlino and the claimed invention as one where Morlino contains a broad disclosure within which the claimed invention falls. While applicants do not agree with this view, it is analogous to a genus-species relationship, where the guidelines of M.P.E.P. § 2131.02 are relevant. Even under these guidelines, Morlino fails to anticipate the claimed invention.

Specifically, when a claimed compound is not specifically named in a prior art reference, but instead it is necessary to select portions of teachings within the reference and combine them (e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition), anticipation can only be found if the classes of substituents are sufficiently limited or well-delineated. M.P.E.P. § 2131.02 (*citing Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990)). Only if one of ordinary skill in the art is able to "at once

envisage" the specific compound within the generic chemical formula, is the compound anticipated. *Id.* In order for the compound to be considered "at once envisaged," one of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula. *Id.*

In the present case, the Office has not cited and the reference does not contain any disclosure from which one would "at once envisage" the claimed amphoteric/anionic surfactant ratio. The Office has only cited Morlino for disclosing compositions comprising "0-30% of one or more amphoteric, cationic, anionic... surfactants." Office Action, page 2, lines 19-20. However, this broad and non-specific disclosure does not teach that both an amphoteric and an anionic surfactant are to be present at the same time, much less sufficiently limit or well delineate the claimed surfactant ratio. Morlino lacks the disclosure of any embodiments comprising both an amphoteric and an anionic surfactant, at any surfactant ratio. Therefore, this disclosure would not allow anyone to at once envision a composition with the claimed amphoteric/anionic surfactant ratio, and Morlino, thus, does not anticipate the claimed invention. Accordingly, the rejection should be withdrawn for this reason alone.

Second, the Office has asserted that the claimed ratio is "inherent." However, the Office has not established (and cannot establish) inherency. Specifically, in order to establish inherency, the Office has the burden of showing more than the mere possibility that the cited reference is capable of performing the claimed function. In fact, "[i]nherency. . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268-69, 20

U.S.P.Q.2d 746, 1749 (Fed. Cir. 1991) (internal citations omitted) (emphasis added).

Likewise, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."

M.P.E.P. § 2112 (emphasis added).

Here, the Office has not provided either factual or technical grounds to establish that the feature necessarily flows from the teaching of the cited reference. Instead, the Office has argued that Morlino's claims encompass the recited ratio of the instant invention. However, even if this is true (though Applicants do not concede this point), it is irrelevant. The Morlino claims put no limit on any surfactant ratio and, hence, cannot possibly render inherent the claimed ratio. The situation thus falls into the case where "a certain result or characteristic may occur or be present in the prior art," however this "is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112. In fact, given that Morlino teaches that the composition need not have any surfactant ("compositions of this invention comprise... [f]rom about 0... weight percent of one or more surfactants," (col. 2, lines 29-36) (emphasis added); "[t]he composition of this invention may also include as an optional ingredient... one or more surfactants," (col. 3, lines 45-48)(emphasis added)), it is impossible for any surfactant ratio to necessarily flow from Morlino. That is, no surfactant ratio (much less the claimed ratio) is inherent in Morlino.

Accordingly, since the Office has not complied (and cannot comply) with the factual and legal requirements necessary for making the required showing of inherency, the rejection should be withdrawn for this reason alone.

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Finally, as set forth in detail in Applicants' Amendment of September 4, 2001, the rejection is improper for at least the reason that the claimed subject matter is not identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); see also M.P.E.P. § 706.02 ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."). The Office has not cited, and Morlino does not contain, any teaching by which one would understand that the composition contains both an amphoteric and an anionic surfactant, and that they should be present such that the amphoteric surfactant/anionic surfactant ratio by weight is greater than or equal to 0.2:1, as claimed. See Applicants' Amendment of September 4, 2001, including pages 15-17. Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 102(b) is improper, and should be withdrawn. Reconsideration and reexamination is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-46 were rejected under 35 U.S.C. § 103(a) as obvious over Morlino in view of U.S. Patent No. 5,567,428 to Hughes (Hughes) and in further view of U.S. Patent No. 5,476,649 to Natio et al. (Natio). Applicants respectfully traverse this rejection.

In order to establish a *prima facie* case of obviousness, the Office must present evidence of (1) a motivation to modify or combine the references, (2) a reasonable expectation of success for the proposed modification or combination, and (3) a teaching

or suggestion of all the claimed elements. See M.P.E.P. § 2143. In the present case, this burden has not been met.

As discussed above, the Office has not shown and Morlino does not teach or suggest a composition comprising both an anionic and an amphoteric surfactant, much less a composition with both surfactants at the claimed ratio. Moreover, the Office has not shown and Morlino does not provide any motivation for selecting a composition comprising both an anionic and an amphoteric surfactant, much less a composition with both surfactants at the claimed ratio. Furthermore, Hughes and Natio have not been cited for and do not overcome these deficiencies.

Accordingly, for at least the reasons that not all the claimed elements are taught or suggested, and that there is no motivation to make the suggested modification/composition, a *prima facie* case of obviousness has not been established. Reconsideration and withdrawal of the rejection is respectfully requested.

DOUBLE PATENTING

The Office stated that Applicants' arguments in response to the double patenting rejection have been considered but deemed not persuasive. Office Action, page 2, lines 4-6. However, the Office Action lacks any specific response to Applicants' arguments, and does not include any clear statement as to why this rejection has apparently been maintained. Accordingly, clarification for the record is respectfully requested.

Furthermore, to the extent that Claims 1-46 remain rejected for obviousness-type double patenting over the claims of U.S. Patent Nos. 6,028,041, 6,159,914, 6,022,836,

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and 5,650,383, Applicants respectfully traverse this rejection for the reasons of record and as further discussed below.

In order to support an obviousness-type double patenting rejection, the Office must establish the same obviousness criteria as for a rejection under 35 U.S.C. § 103. In the present case, however, none of U.S. Patent Nos. 6,028,041, 6,159,914, 6,022,836, and 5,650,383 teaches, suggests, or claims, among other things, the claimed amphoteric/anionic surfactant ratio. The Office has not presented and the references do not contain sufficient evidence to establish that the presently claimed invention is obvious over any or all of these patents.

Accordingly, reconsideration and withdrawal of the rejections is respectfully requested. Should the Office maintain these rejections, it is respectfully requested that a clear statement be included as to how the deficiencies of these references are overcome.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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